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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 09/764,782 | 01/17/2001 | Glenn McGarry | 2785.100 | 7173 |
| 9629 | 7590 | 01/04/2006 | EXAMINER | |
| MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 | | | BORLINGHAUS, JASON M | |
| | | ART UNIT | PAPER NUMBER | |
| | | | 3628 | |

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/764,782 | MCGARRY ET AL. | |
| | Examiner | Art Unit | |
| | Jason M. Borlinghaus | 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 August 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over eSpeed (*eSpeed Signs Deals with 7 Online Brokers to Give Consumers the Ability to Trade Bonds the Same Way They Trade Stocks. PR Newswire*. New York. May 15, 2000. p. 1) in view of ClearCHOICE (*BNY ESI & Co. Launches ClearCHOICE (SM). PR Newswire*. New York. October 5, 1998. p. 1).

eSpeed discloses a system comprising:

- a first computer. (“Online brokers will link their customers to the wholesale bond market through eSpeed Online (SM) Service.” – establishing a first computer, the computers of the linked customers);

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- a second computer for performing middle and back office processing on the same. (“Online brokers will link their customers to the wholesale bond market through eSpeed Online (SM) Service.” – establishing a second computer, the computers of the online brokers linked to their customers. “eSpeed Online, will also link to the brokers’ middle and back office systems, providing a complete end-to-end mechanism for trade execution, risk management, processing and billing.”);
- a communication channel for communicating between the first and second computers. (“Online brokers will link their customers to the wholesale bond market through eSpeed Online (SM) Service.” – establishing that computers are linked through the internet since brokers are “online.”);
- the first computer is a client (customer) computer (supra); and
- the communication channel is the Internet, and the interface is a browser. (“Customers will therefore have the same Web experience they are accustomed they are accustomed to from their online broker.” – establishing the use of the Internet and inherently the interface being a browser).

eSpeed does not teach a system comprising:

- a first computer having an interface for capturing executed trade data;
- a second computer for accepting the captured trade data;
- a communication channel for communicating the captured trade data between the first and second computers.

ClearCHOICE discloses a system comprising:

- a first computer having an interface for capturing executed trade data.
(“ClearCHOICE offers users the ability to eliminate information leakage by efficiently capturing trade data within our straight-through processing platform...”).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified eSpeed by incorporating the capturing of executed trade data, as disclosed by ClearCHOICE, and transmitting such data to the ClearCHOICE data to further “provide a complete end-to-end mechanism for trade execution, risk management, processing and billing.” (see eSpeed).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over eSpeed and ClearCHOICE, as in Claim 1 above, in further view of Downes (Downes, John. *Barron's Finance & Investment Handbook 2nd Edition*. Barron's Educational Services Inc. Hauppauge, New York. 1987. p.311)

eSpeed discloses a system wherein:

- the second computer is an online broker. (“Online brokers will link their customers to the wholesale bond market through eSpeed Online (SM) Service.”)

Neither eSpeed nor ClearCHOICE does not teach a system wherein:

- the second computer is an investment bank.

Downes discloses a system wherein:

- a broker is an investment bank. ("Along with their investment banking functions, the majority of investment bankers also maintain broker-dealer operations, serving both wholesale and retail clients in brokerage and advisory capabilities and offering a growing number of related financial services.")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified eSpeed and ClearCHOICE by having the second computer be an investment bank, as defined by Downes, to expand usage of the system to all groups that provide brokerage services such as investment banks.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over eSpeed in view of Richards (US Patent 5,003,473).

eSpeed discloses a system comprising:

- a client computer. ("Online brokers will link their customers to the wholesale bond market through eSpeed Online (SM) Service." – establishing a first computer, the computers of the linked customers);
- a second computer for performing middle and back office processing on the same. ("Online brokers will link their customers to the wholesale bond market through eSpeed Online (SM) Service." – establishing a second computer, the computers of the online brokers linked to their customers. "eSpeed Online, will also link to the brokers' middle and back office

systems, providing a complete end-to-end mechanism for trade execution, risk management, processing and billing.");

- a communication channel for communicating between the client and second computers. ("Online brokers will link their customers to the wholesale bond market through eSpeed Online (SM) Service." – establishing that computers are linked through the internet since brokers are "online."); and
- the first computer is a client (customer) computer (supra).

eSpeed does not teach a system comprising:

- a client computer having an interface for transmitting electronic trade tickets;
- a second computer for receiving the electronic trade tickets; and
- a communication channel for communicating the electronic trade tickets between the client and second computers.

Richards discloses a system comprising:

- a first computer having an interface transmitting electronic trade tickets. ("A trading ticket output communication system for communicating trading ticket output information relating to a plurality of different type confirmed trading transactions from one or more uniquely identifiable local ticket data bases at which the trading ticket output information is initially collected to a remote back office data base is disclosed in which trading tickets may be requested from a local data base in order of confirmation of trading

transaction independent of the type of trading transaction involved.” – col.

2, lines 25 – 35 – establishing the transmission of electronic trade tickets);

and

- a second computer (remote back office data base) for receiving the electronic trade tickets. (*supra*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified eSpeed by incorporating the transmission and reception of electronic trade tickets, as disclosed by Richards, to further “provide a complete end-to-end mechanism for trade execution, risk management, processing and billing.” (see eSpeed).

Response to Arguments

Applicant's arguments filed 8/24/05 have been fully considered but they are not persuasive.

Regarding the rejection of Claims 1 – 2 and 4 under § 103, the applicant argues that the neither eSpeed, the primary reference, nor ClearCHOICE, the secondary reference, disclose, alone nor in combination, the invention as claimed in Claim 1. The current examiner disagrees.

eSpeed discloses the architecture of the claimed system consisting of multiple computers connected through a network, such as the Internet, an architecture which, even without the primary reference, is old and well known in the art of computer system design. eSpeed also discloses “middle and back office processing” on said computer which, even without the primary reference, would have been obvious to automate, since

alone nor in combination, the invention as claimed in Claim 5. The current examiner disagrees.

eSpeed discloses the architecture of the claimed system consisting of multiple computers, comprising of a client (customer) and second (broker) computer, connected through a network, such as the Internet, an architecture which, even without the primary reference, is old and well known in the art of computer system design. eSpeed also discloses "middle and back office processing" on said computer which, even without the primary reference, would have been obvious to automate, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Richards discloses a computer system that transmits electronic trade tickets from one computer to a second computer that receives said electronic trade tickets via a communication channel. While Richards does not teach communication of the electronic trade tickets between a client computer and a second computer, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have modified eSpeed by incorporating this additional capacity into the trading system disclosed by eSpeed which possessed this old and well known computer architecture of multiple computers, including a client computer and a second computer, connected through a communication network.

Such a combination would have allowed eSpeed to accomplish its stated goals of "providing a complete end-to-end mechanism for trade execution, risk management, processing and billing" (see eSpeed).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

ClearCHOICE discloses a computer system that captures trade data and processes such data within a computer system. While ClearCHOICE does not explicitly state "a computer having an interface for capturing executed trade data", ClearCHOICE does disclose a computer system "efficiently capturing trade data" which would require an a computer having an interface for entering/inputting the captured trade data. While ClearCHOICE does not teach communication of the trade data between multiple computers connected via a communication channel, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have modified eSpeed by incorporating this additional capacity into the trading system disclosed by eSpeed which possessed this old and well known computer architecture of multiple computers connected through a communication network.

Such a combination would have allowed eSpeed to accomplish its stated goals of "providing a complete end-to-end mechanism for trade execution, risk management, processing and billing" (see eSpeed) and would have allowed ClearCHOICE to accomplish its stated goals of "eliminating information leakage by efficiently capturing trade data" for system processing.

Regarding the rejection of Claim 5 under § 103, the applicant argues that the neither eSpeed, the primary reference, nor Richards, the secondary reference, disclose,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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